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IN THE

Supreme Court of the United States

OCTOBER TERM, 1957.

No. 447

EX PARTE JOHN F. BLASKI; PETER S. PEDERSEN, M-P-H MANUFACTURING CORPORATION, INC., PETER S. PEDERSEN, JR., EDWARD MARTIN, AND PETER S. PEDERSEN, CO-PARTNERS, DOING BUSINESS AS CENTRAL FARM EQUIPMENT COMPANY.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT.

Petitioners, plaintiffs-petitioners in the Court below, pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Fifth Circuit, entered in the above-entitled case on June 14, 1957.

OPINIONS OF THE COURTS BELOW.

The opinion of the Court of Appeals for the Fifth Circuit involved herein is not reported, and is printed in Appendix hereto, *infra*, page 1a. The order of the Court of Appeals for the Fifth Circuit denying Petitioner's motion for a rehearing is printed in Appendix hereto, *infra*, page 5a.

The District Court, below, did not hand down an opinion, but the order, transferring this case to the Northern District of Illinois, Eastern Division, and the order overruling Petitioner's motion to vacate the aforementioned transfer order are printed in Appendix hereto, *infra*, at pages 6a and 8a, respectively.

STATEMENT OF THE GROUNDS ON WHICH JURISDICTION OF THIS COURT IS INVOKED.

The judgment of the Court of Appeals for the Fifth Circuit (Appendix, p. 1a) sought to be reviewed by this petition was entered on June 14, 1957.

The order of the Court of Appeals for the Fifth Circuit (Appendix, p. 5a), denying the petition for rehearing below, was entered July 27, 1957, and this petition is, therefore, timely.

The transfer of this case to the Northern District of Illinois, Eastern Division, has been stayed by an order of the District Court, Northern District of Texas, Dallas Division, to permit the filing of this petition for a writ of certiorari.

The jurisdiction of this Court is invoked under Title 28 U. S. C. A., Sec. 1254(1), and Rule 19(1)(b) of the Revised Rules of this Court in view of:

(1) The conflict in a federal question of great importance, between the decision of the Court of Appeals for the Fifth Circuit and applicable decisions of this Court, namely, the decisions in *Ex parte Collett*, 337 U. S. 55; *Pope* v. *Atlantic Coast Line Railroad Company*, 345 U. S. 379; and *Fourco Glass Company* v. *Transmission Products Corporation*, 353 U. S. 222, 1 L. Ed. 2d 786;

(2) The conflict between the decision of the Court of Appeals for the Fifth Circuit in this case, and the decision of the Court of Appeals for the Ninth Circuit in the case of *Shapiro* v. *Bonanza Hotel Co.* (C. C. A. 9, 1950), 185 F. 2d 777, 780; and

(3) The admitted conflict (Appendix, p. 3a) between the decision of the Court of Appeals for the Fifth Circuit and the decisions of District Courts in six other circuits, namely, the decisions in:

(a) *Hampton Theatres, Inc.* v. *Paramount Film Distributing Corp.* (D. C. D. C. 1950), 90 F. Supp. 645 (Tamm, *J.*);

(b) *Johnson* v. *Harris* (D. C. Tenn. 1953), 112 F. Supp. 338 (Darr, *J.*);

(c) *Sheridan* v. *Pan-American Refining Corp.* (D. C. N. Y. 1954), 123 F. Supp. 81 (Edelstein, *J.*);

(d) *General Electric Co.* v. *Central Transit Warehouse Co.* (D. C. Mo. 1955), 127 F. Supp. 817 (Whittaker, *J.*);

(e) *Mitchell* v. *Gundlach* (D. C. Md. 1955), 136 F. Supp. 169 (Chesnut, *J.*);

(f) *Felchlin* v. *American Smelting & Refining Co.* (D. C. Calif. 1955), 136 F. Supp. 577 (Jertberg, *J.*).

QUESTION PRESENTED.

The important federal question presented herein is: Does a District Court, in a district in which an action for patent infringement is properly brought under Title 28 U. S. C. A. Sec. 1400(b), have the power, under Title 28 U. S. C. A. Sec. 1404(a), upon motion of the defendants and over the objections of the plaintiffs, to transfer the cause to another district in another circuit where the action could not originally have been brought, in which latter district none of the defendants reside, and none of the defendants have committed acts of infringement or have a regular and established place of business?

STATUTES INVOLVED.

The two statutes here involved are Title 28 U. S. C. A. Secs. 1400(b) and 1404(a), which read as follows:

Title 28 U. S. C. A. Sec. 1400. **Patents and copyrights**

(b) Any civil action for patent infringement may be brought in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.

Title 28 U. S. C. A. Sec. 1404. **Change of venue**

(a) For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought.

STATEMENT OF THE CASE.

This petition relates to a cause of action for paten infringement brought in the United States District Cour for the Northern District of Texas, Dallas Division, o March 1, 1957, by the petitioners, John F. Blaski *et al* as plaintiffs, against respondents, R. P. Howell, Jr. an Lifetime Metal Building Co., a Texas corporation, as de fendants. All of the defendants in the cause of actio reside and are doing business within the Northern Distric of Texas, Dallas Division, while no one of the defendant either resides, or is doing business, within the Northern District of Illinois. In their complaint, the plaintiff alleged that certain acts of the defendants infringed tw United States Letters Patent issued to John F. Blask and identified as Patent Nos. 2,436,543 and 2,526,323. Th complaint further alleged that said acts of patent infringe ment were committed by the defendants in the Northern District of Texas, Dallas Division. No acts of infringe ment have been committed by any of the defendants in th Northern District of Illinois, within the knowledge o belief of petitioners herein.

Hence, it will be seen that venue was proper in th Northern District of Texas, and would not have bee proper in the Northern District of Illinois under Title 28 U. S. C. A., Sec. 1400(b).

The defendants-respondents filed their answer to th aforementioned complaint on March 22, 1957 and the actio was set for trial on May 31, 1957 as a non-jury case befor The Honorable William H. Atwell. Thereafter, on Marc 28, 1957, the defendants-respondents filed a jury demand which was opposed by the plaintiffs, and because of th jury demand the action was then assigned to the jury cal endar before The Honorable T. Whitfield Davidson. O March 29, 1957, plaintiffs-petitioners filed a motion t

strike defendants' demand for a jury and noticed the matter for hearing on Monday, April 8, 1957. Prior to the hearing on plaintiffs-petitioners' motion to strike defendants' demand for a jury, the defendants-respondents submitted a second motion, requesting transfer of the cause of action to the Northern District of Illinois, Eastern Division, under Title 28, U. S. C. A., Sec. 1404(a), stating in their motion that defendants waived lack of venue in the Northern District of Illinois. The plaintiffs-petitioners opposed this second motion of the defendants-respondents and oral arguments were had with respect to this matter before The Honorable T. Whitfield Davidson on April 11, 1957. On April 16, 1957, Judge Davidson entered an order directing that for the convenience of parties and witnesses, in the interest of justice the aforementioned civil action be transferred to the United States District Court for the Northern District of Illinois, Eastern Division.

Immediately thereafter, on April 17, 1957, the plaintiffs-petitioners filed a motion in the United States District Court, Northern District of Texas, Dallas Division, requesting that the order to transfer be vacated. On April 22, 1957, the aforementioned District Court overruled the plaintiffs-petitioners' motion to vacate and thereafter, on May 18, 1957, the plaintiffs-petitioners filed a motion for leave to file a petition for a writ of mandamus in the United States Court of Appeals for the Fifth Circuit requesting that Court to issue an order to show cause why a writ of mandamus should not be issued against Judge Davidson nullifying the aforementioned order of April 16, 1957, transferring the aforementioned civil action to the Northern District of Illinois, Eastern Division.

In an opinion dated June 14, 1957 (Appendix, p. 1a) the Court of Appeals for the Fifth Circuit handed down a decision denying plaintiffs-petitioners' motion for leave

to file a petition for a writ of mandamus, although specifically acknowledging (Appendix, p. 3a) that its decision was in conflict with a number of district court decisions. The plaintiffs-petitioners thereupon filed a petition for rehearing in the Court of Appeals below. The defendants-respondents did not oppose or contest the petition for rehearing. However, on July 27, 1957, the Court of Appeals below issued an order denying the petition for rehearing (Appendix, p. 5a).

REASONS FOR GRANTING THE WRIT.

1. The decision of the Court below is in conflict with the applicable decisions of this Court in *Ex parte Collett*, 337 U. S. 55; *Pope* v. *Atlantic Coast Line Railroad Company*, 345 U. S. 379; and *Fourco Glass Company* v. *Transmission Products Corporation*, 353 U. S. 222, 1 L. Ed. 786; and is directly contrary to the express provisions of Sections 1400(b) and 1404(a), Title 28, U. S. C. A., which are the controlling statutes in this case.

This is a patent infringement action, and, therefore, Section 1400(b), Title 28, U. S. C. A. is controlling as to *original* venue with respect thereto. This section specifically states *where* such an action may be brought, providing as follows:

> "Any civil action for patent infringement *may be brought* in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business."

Section 1404(a), Title 28, U. S. C. A. is controlling as to any *change* of venue with respect to this action and provides that:

> "* * * a district court may transfer any civil action

to any other district or division *where it might have been brought.*"*

It is to be noted that the "may be brought" language is identical (except for tense) in both of the aforementioned statutes.

Prior to the adoption of Section 1404(a), Title 28, U. S. C. A., it was well established law, under the doctrine of *forum non conveniens*, that:

> "In *all* cases in which the doctrine of *forum non conveniens*" came into play, it presupposed "at least two forums in which the defendant is amenable to process." *Gulf Oil Corp.* v. *Gilbert*, 330 U. S. 501.

At least twice since the adoption of Section 1404(a), Title 28, U. S. C. A., this Court has recognized that, under that section of the statute, just as under the doctrine of *forum non conveniens*, a district court does not have the power to transfer a civil action to another forum unless the civil action could have been properly brought in that other forum originally.

Thus, in the case of *Ex parte Collett*, 337 U. S. 55, this Court recognized that any change of venue under Section 1404(a) is in accordance with the doctrine of *forum non conveniens;* that Section 1404(a) was carefully considered by Congress and is clear and unambiguous; and that the Congressional recognition of the doctrine of *forum non conveniens* afforded by Section 1404(a) applies to *all* civil actions, including those actions arising under special venue statutes, such as, for example, suits for patent infringement. In that case, this Court stated as follows at pages 58, 65, 68, 69 and 71:

> "The reviser's notes, which accompany each section of the Code, here read as follows: 'Sub-section (a)

* Emphasis added throughout this petition unless otherwise indicated.

was drafted *in accordance with the doctrine of forum non conveniens*, permitting transfer to a more convenient forum, even though the venue is proper.' "

. . . . . .

"The Court below relied on the language of Sec. 1404(a), *supra*, which is regarded as *'unambiguous, direct, clear.' We agree.*"

. . . . . .

"*This was scarcely hasty, ill-considered legislation. To the contrary, it received close and prolonged study.* Five years of Congressional attention supports the Code. And from the start, Congress obtained the most eminent expert assistance available."

. . . . . .

"The initial appearance of Sec. 1404(a) was in the Second Draft of the Code, adopted by the meeting of May, 1945. Its text has remained unchanged. It was accompanied by a reviser's note, which recited that 'Subsection (a) is new. *It was drafted in accordance with a memorandum* of May 7, 1945, from the author of Moore's Federal Practice, *stating that recognition should be given the doctrine of forum non conveniens.* [29]"

. . . . . .

"From the start, Sec. 1404(a) remained the same, and the reference in the note to a Federal Employers' Liability Act case as showing the need for permitting *the application of forum non conveniens* remained unchanged. Now to hold that Congress did not appreciate what it was enacting in that section would *defy* the legislative history."

It will be noted that the last two sentences quoted above apply equally as well to suits for patent infringement which were also specifically referred to in the reviser's note (see footnote 29).

The footnote "29" indicated above stated:

"There is no doubt as to the meaning of Sec. 1404(a) in the mind of the author of the memorandum. See

3 Moore's Federal Practice 2141, 2d ed, stating that the Code 'provides for a transfer * * * of *any* action to a *proper* and more convenient forum' (italics in original),* with a footnote (107) citing Sec. 1404(a) and declaring that 'ANY *action* in Sec. 1404(a) includes suits subject to *special venue* statutes, as *suits for patent infringement* and suits under the Federal Employers' Liability Act; as well as actions subject to the general venue statute.'"

In the later case of *Pope* v. *Atlantic Coast Line Railroad Company*, 345 U. S. 379, this Court cited with approval the abovementioned case of *Ex parte Collett*, and, with respect to Section 1404(a) stated as follows, at page 384:

"* * * its *limited* purpose is to authorize, under certain circumstances, the transfer of a civil action from one federal forum to another federal forum *in which the action 'might have been brought'*."

It is submitted that the decision of the Court of Appeals below, permitting transfer to a district in which the action could *not* have been brought, is in conflict with these decisions of this Court, and is directly contrary to the express provisions of the applicable statutes, namely Title 28, U. S. C. A. Sections 1400(b) and 1404(a).

This Court has recently held in the case of *Fourco Glass Company* v. *Transmission Products Corporation*, (April 29, 1957) 353 U. S. 222, 1 L. ed. 2d 786, that Section 1400 (b) Title 28, U. S. C. A. is the sole and exclusive statutory provision governing venue in patent infringement cases, stating in part as follows at page 789:

"We hold that 28 U. S. C. A. Sec. 1400(b) is the *sole and exclusive* provision controlling venue in patent infringement actions, * * *"

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* This parenthetical insert, appearing in the original decision, applies only to the word "any", thereabove.

Section 1400(b), Title 28, U. S. C. A. provides *only* that a patent infringement action "*may be brought*" in the judicial district:

(1) "where the defendant resides, or"

(2) "where the defendant has committed acts of infringement and has a regular and established place of business."

None of the defendants resides in, has a regular and established place of business in, or, to petitioners' knowledge, has committed any acts of infringement in, the Northern District of Illinois. Hence this action could not have been brought, and may not now be brought, in the Northern District of Illinois under Section 1400(b), which clearly provides where the action may be brought, and which this Court has recently held is the *sole and exclusive* provision controlling venue in patent infringement actions.

By its decision in this case, the Court of Appeals below has ruled that the words "might have been brought" in the venue statute, Title 28 U. S. C. A. Sec. 1404(a) are meaningless, and that this section of the statute should be read as though those words were not contained therein because, in the Court of Appeals' opinion, such a transfer may be made to any other District Court, whether or not the action could have been *properly* brought in that district. This ignores the fact that:

(1) This Court has ruled that the language of Section 1404(a) is "unambiguous, direct, clear", and that it "'provides for a transfer * * * of any action to a *proper* and more convenient forum'", *Ex parte Collett*, 337 U. S. 55, *infra;*

(2) The "might have been brought" provision of the change of venue statute, Title 28 U. S. C. A. Sec. 1404(a) is the same identical provision (except that it is a different tense) as the "may be brought" provision of the patent statute under which this action was brought, Title 28 U. S. C. A. Sec. 1400(b), and that

this Court has ruled that under the patent statute a patent infringement action "may be brought" *only* in a district where a defendant resides, or where the defendant has a regular and established place of business, as specifically provided in Sec. 1400(b), *Fourco Glass Company* v. *Transmission Products Corporation*, 353 U. S. 222, *supra*; and

(3) The *existence* of the power of a District Court to transfer an action to another district is *entirely jurisdictional*, and may *only* be exercised in strict accordance with the *express provisions of the statutory grant* (*Felchlin* v. *American Smelting and Refining Company*, D. C. S. D. Calif., N. D., 136 F. Supp. 577, 580, 581), so that a District Court may not completely devitalize a statute by altogether ignoring an express limitation as to which districts an action may be transferred to by holding that such an action may be transferred to *any* district on the reasoning that the action might have been *improperly* filed in any district.

2. Also, this holding is in conflict with the decision of the Court of Appeals for the Ninth Circuit in the case of *Shapiro* v. *Bonanza Hotel Co.*, 185 F. 2d 777, which the Court of Appeals for the Fifth Circuit previously expressly recognized as proper, contrary to the present decision. In the *Shapiro* case the Court of Appeals for the Ninth Circuit stated as follows, at page 780:

> "Prior to the adoption of Sec. 1404(a) the Supreme Court[7] significantly stated that *the doctrine of forum non conveniens 'presupposes at least two forums in which the defendant is amenable to process'*. We are persuaded that Congress did not intend, by the use of the one word 'brought', to change this rule. *We adhere to the view that use of the word 'brought' presupposes jurisdiction over the defendant which is to be obtained only by and through conformance with the requirements of Rule 4(f).*"

The footnote "(7)" indicated above stated:

> "*Gulf Oil Corp.* v. *Gilbert*, 330 U. S. 501, 67 S. Ct. 839, 91 L. Ed. 1055; see also *Wilson* v. *Seas Shipping*

Co., Inc., D. C., 78 F. Supp. 464, wherein the court refused to transfer an action under the *forum non conveniens* doctrine made by the defendant *where the defendant had not shown that he was amenable to process in the district.*"

Quite significantly, the specific conflict above identified is, in actuality, a mere isolated instance of widespread conflict which exists in the federal judicial system with respect to the question presented by this petition.

It is interesting to note that previous to the present decision from which this petition is taken, in the case of *Blackman* v. *Guerre, et al.* (C. C. A. 5, 1951), 190 F. 2d 427 the Court below expressly recognized that the Court of Appeals for the Ninth Circuit in the *Shapiro* case correctly stated the law, and that the *Shapiro* holding was contrary to the present holding of the Court of Appeals for the Fifth Circuit, stating as follows, at page 429:

> "Transfer under those sections is *limited* to districts where the suit could be originally brought: *Putnam* v. *Ickes*, 64 App. D. C. 339, 78 F. 2d 223. Compare *Foster-Milburn Co.* v. *Knight*, 2 Cir., 181 F. 2d 949; *Shapiro* v. *Bonanza Hotel Co.*, 9 Cir., 185 F. 2d 777."

Curiously enough, however, the court below, in denying the petitioner's motion, refused to abide by and follow this previous recognition of this limitation of a court's power to transfer, which it had previously clearly pointed out in the *Blackman* v. *Guerre, et al.* case.

3. The opinion of the Court below, as expressly admitted in its opinion (Appendix, p. 3a), is in conflict with the decisions of District Courts in six different circuits.

One of the decisions with which the opinion below is admittedly in conflict is the carefully reasoned opinion of then District Judge Whittaker in the case of *General Electric Company* v. *Central Transit Warehouse Company, et al.* (W. D. Mo. W. D., 1955), 127 F. Supp. 817. In that

case Judge Whittaker discussed at some length the meaning of "might have been brought" in Sec. 1404(a) in ruling on a motion of *defendant* for change of venue (granted because by plaintiff's complaint the defendants were "doing business" in the forum to which the transfer was requested). In ruling on the meaning of "might have been brought" in Sec. 1404(a) Judge Whittaker stated as follows, at pages 825, 826 and 827 (Emphasis the court's):

> "We recognize of course, that venue can be waived. So can jurisdiction over the person be waived. But does such a waiver of either or both—made *after* an action has been 'commenced' (by the mere filing of a complaint with the clerk *in any district*, see Fed. Rules Civ. Proc. Rule 3, 28 U. S. C. A.)—establish that the action 'might have been brought' there, in the sense of that phrase as used in Section 1404(a), Title 28 U. S. C. A.? If it does, what, if any, meaning is left to the phrase 'where it might have been brought', as adopted by Congress and used in the statute? Would not such construction permit transfer of the action to *any district desired by the moving defendants*, though they, or some of them, could not have been served with process there, and no statutory venue existed there and the action could not have been *maintained* there, without their intentional waiver of venue and entry of general appearance? I think no such treatment can be given to that phrase in the statute. It, says Judge Learned Hand, 'presupposes at least two forums in which the defendant is amenable to process'. *Foster-Milburn Co.* v. *Knight*, 2 Cir., 181 F. 2d 949, 952.
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> . . . . . .
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> "We adhere to our original conclusion that a district court is without power to transfer a cause, under Section 1404(a), Title 28 U. S. C. A., to a district without statutory venue and wherein service of process could not have been had and involuntary personal jurisdiction acquired, because, under these circumstances, the action could not have been 'brought' in that district."

At least five of the six cases admittedly in conflict with the present holding of this Court are cases wherein the defendant brought the motion to transfer, and all six of the cases support the plaintiffs' position in this case.

Thus, in the case of *Hampton Theatre, Inc.* v. *Paramount Film Distributing Corporation, et al.*, 90 F. Supp. 645 (D. C., D. C., 1950), it was the defendants who moved to transfer the case to a forum in which they were neither "transacting" nor "doing business" as required by the venue statute under which the action was brought. In denying the *defendants'* motion, the Court (Tamm, J.) stated as follows, at page 647:

> **"However, this Court is of the opinion that the defendants are not 'transacting' or 'doing' business in Virginia within the provisions of the statute under which this action is brought and that consequently the action could not have been maintained in Virginia. The court is of the further opinion that there could be no valid service of process in Virginia. *Since the action could not be maintained in Virginia, the Court may not under Sec. 1404(a) of T. 28 of the United States Code Annotated transfer the action there.*"**

In the case of *Johnson* v. *Harris* (D. C., E. D. Tenn. S. D., 1953), 112 F. Supp. 338, in denying the *defendant's* motion to transfer the case to a district in which there would not have been proper venue originally, the Court (Darr, J.) stated as follows at page 341:

> "In fact, the statute, Section 1404(a), Title 28, U. S. C. A., providing for transfer of a case *contemplates statutory venue and not consent venue.*"

In the case of *Sheridan, et al.* v. *Pan-American Refining Corp., et al.* (D. C., S. D. N. Y., 1954), 123 F. Supp. 81, proper statutory venue did not originally exist for either defendant in the forum to which the transfer was requested. In denying the motion of *both defendants* to

transfer the case to this latter forum, the Court (Edelestein, J.) stated as follows, at page 82:

> *"It does not, therefore, appear that this suit could have been brought* in the District Court for the Southern District of Texas, and *accordingly the motion will be denied."*

In the case of *Felchlin* v. *American Smelting and Refining Company*, 136 F. Supp. 577 (D. S. S. D. Calif., N. D., 1955), in denying a motion of *defendant* for a change of venue to a forum where the action could not have been brought originally, the Court (Jertberg, J.) stated as follows, at pages 580 and 581:

> "The plaintiff could not have 'brought' the action there originally. *This is not a question of venue or jurisdiction that can be waived by the parties. It is a question of the power of a Court to transfer the action.* This is a case similar to *United States* v. *11 Cases, etc.*, D. C., 94 F. Supp. 925, 927, in which Judge Fee, presently a member of the Ninth Circuit Court of Appeals, said that *the existence of the power of transfer is jurisdictional, and may only be exercised in strict accordance with the statutory grant.*
>
> • • • • •
>
> "A District Court is a separate entity. No District Court has jurisdiction crossing a state line. *By virtue of these limitations, the transfer of any cause from one district to another is a question of power. No District Court has such inherent authority. There must be an express statutory grant as a condition precedent to the initiation of the transfer, and every essential factor must be present to confer jurisdiction on the court to which the case is sent.* If this action could have been brought originally in the Texas courts, the transfer to Texas would then be possible, but since the action is one based on diversity of citizenship, the law of Texas would apply. *United States* v. *11 Cases, etc.*, 94 F. Supp. 925. Statutory authority to transfer an action to a district or division 'where

it might have been brought' certainly does not authorize transfer to a district where the action might not have been brought. *General Electric Co.* v. *Central Transit Warehouse Co.*, 127 F. Supp. 817. The *phrase* 'might have been brought' *means* the place where the plaintiff had the *right* to institute the suit originally. *Greve* v. *Gibraltar Enterprises*, D. C. N. M. 85 F. Supp. 410, 412.

The case of *Mitchell* v. *Gundlech* (D. C. Md., 1955), 136 F. Supp. 169, referred to by the Court below in its opinion as being in conflict with its holding is distinguishable on its facts in that, in that case, it was the plaintiff bringing the motion to transfer. However, in its opinion in the *Mitchell* case, the Court (Chesnut, J.) set forth a very comprehensive discussion of Sec. 1404(a), which supports the plaintiff in the present action, and in which, incidentally, it stated (pages 174 and 175) that, based on the *Blackmar* v. *Guerre* decision of the Court of Appeals for the Fifth Circuit Court, it was the opinion of the Court of Appeals below that transfer under Sec. 1404(a) could be made *only* to a forum which would have had *original statutory venue* and jurisdiction. That is a correct statement of the law, and is contrary to the present holding of the Court below.

CONCLUSION.

For the reasons stated, and under the authorities cited, it is submitted that the decision of the Court of Appeals for the Fifth Circuit denying petitioners motion for leave to file a petition for mandamus is in error, and that this petition for a writ of certiorari to that court to review its action in so holding is well founded in fact and in law and should be granted.

Respectfully submitted,

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IN THE UNITED STATES COURT OF APPEALS

For the Fifth Circuit.

No. 16686.

EX PARTE JOHN F. BLASKI, ET AL.

MOTION FOR LEAVE TO FILE PETITION FOR A WRIT OF MANDAMUS.

(June 14, 1957.)

Before RIVES, JONES and BROWN, Circuit Judges.

JONES, Circuit Judge: The movants here, who were plaintiffs in the district court, have their residence in the Northern District of Illinois. They instituted suit in the district court for the Northern District of Texas against several defendants, all of whom reside in the Northern District of Texas. The complaint charged patent infringement. The defendants made a motion to transfer the cause, pursuant to 28 U.S.C.A. §1404(a), to the Northern District of Illinois. In their motion the defendants stated that their witnesses were much closer to the court in Illinois than to the court in Texas. They also stated, among other averments, that there is pending in the district court for the Northern District of Illinois a consolidated action in which the plaintiffs in the Texas suit were charging infringement of the same patent as was involved in the suit in Texas. It was shown that in the action in the Northern District of Illinois much pre-trial information and evidence had been developed which

would be relevant in the case commenced in the Northern District of Texas. The defendants waived their right to be sued in the Northern District of Texas and consented to the consolidation of the action with the cause pending in Illinois. An order was entered transferring the cause to the Northern District of Illinois. The plaintiffs, by motion, unsuccessfully sought from the district court an order vacating the order of transfer. The plaintiffs, John P. Blaski and others, have filed in this court their motion for leave to file a petition for a writ of mandamus to require the district court to vacate and set aside the order of transfer. This motion we now consider.

The authority for ordering the transfer is the statutory enactment which provides:

> "For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought." 28 U.S.C.A., §1404(a).

Congress has prescribed venue in patent infringement cases in this language:

> "Any civil action for patent infringement may be brought in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business." 28 U.S.C.A. §1400(b).

The plaintiffs say that none of the defendants reside in Illinois and have not committed in Illinois any acts of infringement, that process issued in Illinois could not have been served on the defendants and therefore the action could not "have been brought" in the district to which it was transferred. The attempted waiver, the plaintiffs say, is ineffectual.

It has been held in this Circuit that unless the district court has failed correctly to construe and apply the statute, consider the relevant factors incident to a motion

to transfer, or has clearly abused its discretion, a Court of Appeals should not entertain applications for mandamus to enter or vacate orders of transfer under §1404(a). *Ex Parte Chas. Pfizer & Co.*, 5 Cir. 1955, 225 F. 2d 720; *Ex Parte Pharma-Craft Corporation*, 5 Cir. 1956, 236 F. 2d 911. Cf. *Atlantic Coast Line R. Co.* v. *Davis*, 5 Cir. 1950, 185 F. 2d 766. In supporting the position that the district court erroneously construed and applied the statute in the determination, implicit in its order of transfer, that the action might have been brought in the Northern District of Illinois, the plaintiff-movants cite *Blackman* v. *Guerre*, 5 Cir. 1951, 190 F. 2d 427. In that opinion it was said with respect to the cause there decided that the action could not have been transferred under §1404(a) to the District of Columbia because a defendant was a resident of Louisiana. An examination of the opinion will show that the statement of the court was neither necessary to the decision nor upon a question involved in the appeal. The decision is not a precedent on the question we have before us. The Supreme Court affirmed *Blackman* v. *Guerre* without considering the point with which we are here concerned. *Blackman* v. *Guerre*, 342 U. S. 512, 72 S. Ct. 410, 96 L. Ed. 534.

There are a number of district court decisions holding that even though a defendant moves for a transfer, the court has no power to grant the motion where the defendants are not subject to service in the transferee district. *Hampton Theatres, Inc.* v. *Paramount Film Distributing Corp.*, D.C.D.C. 1950, 90 F. Supp. 645; *Johnson* v. *Harris*, D.C. Tenn. 1953, 112 F. Supp. 338; *Sheridan* v. *Pan-American Refining Corp.*, D.C.N.Y. 1954, 123 F. Supp. 81; *General Electric Co.* v. *Central Transit Warehouse Co.*, D.C.Mo. 1955, 127 F. Supp. 817; *Mitchell* v. *Gundlach*, D.C.Md. 1955, 136 F. Supp. 169; *Felchlin* v. *American Smelting & Refining Co.*, D.C.Calif. 1955, 136 F. Supp.

577. The rule which to us seems the better reasoned and which has been adopted by the majority of the courts, permits the transfer upon the motion or with the consent of the defendants even though they could not have been served with the process of the transferee court. *Paramount Pictures, Inc.* v. *Rodney*, 3 Cir. 1951, 186 F. 2d 111, cert. den. 340 U. S. 953, 71 S. Ct. 572, 95 L. Ed. 687; *Anthony* v. *Kaufman*, 2d Cir. 1951, 193 F. 2d 85, cert. den. 342 U. S. 955, 72 S. Ct. 629, 96 L. Ed. 710; *In re Josephson*, 1 Cir. 1954, 218 F. 2d 174; *Torres* v. *Walsh*, 2nd Cir. 1955, 221 F. 2d 319. A number of district court decisions arrive at like results. The purposes for which §1404(a) was enacted would be unduly circumscribed if a transfer could not be made "in the interest of justice" to a district where the defendants not only waive venue but to which they seek the transfer. The interpretation of the phrase "where it might have been brought", as used in 28 U.S. C.A. §1404(a), is discussed at length by Chief Judge Magruder of the First Circuit in the case of *In re Josephson, supra*. We need not labor the point here.

The district court was empowered by the statute to make the transfer. It is not shown that the district court misconstrued or misapplied the statute or failed to consider all pertinent facts. No abuse of discretion is shown. The rule announced in *Ex Parte Chas. Pfizer & Co., supra*, is applicable. The motion for leave to file a petition for a writ of mandamus is

DENIED.

ORDER DENYING REHEARING.

Extract from the Minutes of July 27, 1957.

No. 16686,

IN RE:

JOHN F. BLASKI, ET AL.,

PRAYING FOR A WRIT OF MANDAMUS.

It is ordered by the Court that the petition for rehearing filed in this cause be, and the same is hereby, denied.

IN THE DISTRICT COURT OF THE UNITED STATES
for the Northern District of Texas
Dallas Division.

JOHN F. BLASKI, PETER S. PEDERSEN, M-P-H MANUFACTURING CORPORATION, INC., PETER S. PEDERSEN, JR., EDWARD MARTIN, and PETER S. PEDERSEN, Co-Partners, doing business as Central Farm Equipment Company,
Plaintiffs,
vs.
R. P. HOWELL, JR. and LIFETIME METAL BUILDING COMPANY,
Defendants.
} Civil Action No. 7607

ORDER OF TRANSFER.

The defendants having moved for an order transferring the venue of this cause to the United States District Court for the Northern District of Illinois, Eastern Division, and said motion having duly come on to be heard on April 11, 1957, and the Court having heard the argument of counsel and being fully advised, and it appearing to the Court that defendants' motion should be granted for the convenience of parties and witnesses in the interest of justice, it is

ORDERED, that this action be transferred from the United States District Court for the Northern District of Texas, Dallas Division, and it is further

ORDERED, that the Clerk of this United States District

Court for the Northern District of Texas, be and hereby is directed to transfer all records and papers in this action, together with the deposit made by the plaintiffs, to the Clerk of the United States District Court for the Northern District of Illinois, Eastern Division, together with a certified copy of this order.

Dated April 16, 1957.

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United States District Judge.

IN THE UNITED STATES DISTRICT COURT

Northern District of Texas

Dallas Division.

JOHN F. BLASKI, ET AL
vs.
R. P. HOWELL, JR., ET AL } Civil Action No. 7007

ORDER OVERRULING MOTION TO VACATE.

On this the 22nd day of April, 1957, came on to be heard the motion of plaintiffs to vacate the order heretofore entered by this court changing venue of this cause to the United States District Court for the Northern District of Illinois, Eastern Division, and the court having heard and considered such motion and being of the opinion that same should be overruled;

It is, therefore, ordered that the motion of plaintiffs herein to vacate this court's order changing venue to the United States District Court for the Northern District of Illinois, Eastern Division be and the same is hereby overruled and denied.

/s/
United States District Judge.